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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,870	03/09/2001	Rhoda K. Camin	05997.0015	6725

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/801,870	CAMIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH PATEL	3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 6/5/06.

#### ***Response to Amendment***

2. Claims 1, 10, 12, 14, and 19-21 have been amended and new claims 22-29 have been added.

#### ***Response to Arguments***

3. Applicant's arguments with respect to rejection of claims under 35 USC § 112 (second) have been considered have been fully considered. Although, prior issues concerning indefiniteness has been addressed by the applicant's arguments and accompanying amendment of the claims, the examiner has raised new issues concerning the indefiniteness resulting from the conditional limitations. (see 35 USC § 112 rejection below.) The claims also contain deficiency concerning proper antecedent basis as explained in detail below.
4. Applicant's arguments with respect to rejection of claims under 35 USC § 102 over Katz reference are not persuasive considering the breadth of the claim limitations. See explanation provided below under 35 USC § 102 rejection.

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5. The pending claims have been rejected under the revised Interim Guidelines for patentability under 35 USC 101. See detailed analysis provided in the following section.

### **Claim Rejections - 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link,

[http://www.uspto.gov/web/offices/pac/compexam/interim\\_guide\\_subj\\_matter\\_eligibility.html](http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html))

for details), a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

To determine whether the claimed invention satisfies the "practical application" requirement, the claimed invention must produce a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable

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exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

Exemplary analysis of claim 1 is provided which applies to all independent and dependent claims.

Claim 1 recites a method for processing loan information. The claim recites the steps of evaluating loan information stored in one or more “staging tables”. The intended purpose of the evaluation process is to “identify one or more triggers” that are satisfied based on “one or more predetermined conditions”. The claim further recites steps of (a) identifying one or more rules and (b) retrieving the stored loan information from the staging tables when “at least one of the one or more triggers” is satisfied. Finally, the claim recites transforming the retrieved information into “one or more outputs” based on at least the one or more rules.

It is noted that the claim fails to define the terms “loan information”, “one or more triggers” and “one or more rules” and “one or more outputs” with any specificity or “concreteness”. The step of evaluating the loan information is too broad, even when considered in view of its objective which is to identify “one or more triggers” as defined in the claim. This is, because, the terms “triggers” and “predetermined conditions” have no specified relationship to the loan information. Finally, the claim refers to “one or more outputs” without defining the output with any specificity, in the context of the loan information.

Claim 1, when viewed, as a whole is a data processing method pertaining to loan information as discussed above. However, one cannot ascertain specifically what the output of

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the data processing steps is. At best, one may interpret that the output(s) is related to the loan information.

In other words, the claim fails to produce a result, which meets requirements of the practical application as specified earlier. The claim fails to produce useful, concrete and tangible result as further explained in the following paragraphs.

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107 and Fisher, 421 F.3d at 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of “specific” and “substantial”). The claim fails this requirement because it is not specific about the result it produces (i.e. outputs). Note that the claimed invention also must recite some utility of outputs once such outputs are specifically defined.

For the reasons discussed above, the claimed invention also fails to produce “concrete “ and “tangible” result.

8. This analysis also applies to independent claims 10, 14, 19, 20, 21, 22 and 26 and all dependent claims therefrom as none of these claims produce a tangible result.

### **Claim Rejections - 35 USC § 112**

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9. Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Note that analysis of claim 1 is provided as exemplary of all claims.

10 Claim 1 does not recite the process step of identifying one or more triggers in a positive manner (such as “identifying one or more triggers..by evaluating the loan information...”).

Instead the identifying the triggers is only recited as intended result of the evaluation of the loan information. Therefore, in the subsequent the limitation(s) “the one or more triggers” lack positive antecedent basis.

11. Claim 1 is also indefinite because of the conditional statements “when at least one or more triggers is satisfied” etc., which renders the claim indefinite because the scope of the claim when the conditions are not satisfied cannot be determined. For example, the scope of the claim when the “one or more triggers” are not satisfied cannot be determined. [Note that the opposite condition of “one or more triggers” satisfied is “no trigger” is satisfied.].

Claim 22: the limitation “code for sequencing ..” does not correlate to the limitation “code for transforming”. The examiner has considered the latter as “code for ..the one or more sequenced rules” to correspond to method claim 10. Similar analysis also applies to independent claim 26. Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

12. Claims 1-8 and 14-21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katz et al. (US 6,993,505). (hereafter Katz).

With regards to claim 1, Katz discloses a method for processing loan information using a financial system, comprising the steps of:

receiving loan information from one or more source systems;

(col. 5 L 65- col. 6 L 4 “collecting and analyzing loan data from all the offices of a financial institution”, col. 7 L 32-39, “variety of sources are fed into a computer system” );  
storing the loan information in one or more staging tables;

(col. 6 L 36- 52, “central repository”)

evaluating the loan information stored in the one or more staging tables to identify one or more triggers that are satisfied based on one or more predetermined conditions;

(col. 6 L 53-60, year-to-date analysis for further processing, col. 7 L 47-58 “analysis and reporting” the loan data is evaluated for CRA and HMDA compliance and col. 10 L 21-24 “ only processes those accounts that are either new bookings or **were renewed or received line increases during the current processing period**”, triggers=new bookings, loan accounts are evaluated to determine new bookings etc.)

identifying one or more rules, when at least one of the one or more triggers is satisfied;

(col. 6 L 53-60 **Rules = CRA and HMDA (fair lending acts) identified for the aforementioned loan accounts when the triggers are satisfied**)

retrieving stored loan information from at least one of the one or more staging tables to form retrieved information, when at least one of the one or more triggers is satisfied; and

(col. 6 L 53-60, year-to-date analysis for further processing, col. 7 L 47-58 “analysis and reporting” the loan data is evaluated for CRA and HMDA compliance and col. 10 L 21-24 “ only processes those accounts that are either new bookings or were renewed or received line increases during the current processing period”)

transforming the retrieved information into one or more outputs based on at least one of the one or more rules.



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(COL. 6 L 53-60 “internal MIS reports are prepared and regulatory fillings are developed **consistent with the CRA and HMDA**).

Claim 2: Katz teaches, linking the one or more source systems to the financial system. (Figure 1, various feeds are linked to the financial system).

Claim 3: Katz teaches, storing the one or more outputs in a data repository. (refer to claim 1 storing is inherent to such a system).

Claim 4: Katz teaches, responding the stored one or more outputs.

(col. 14 Year-to Date Master maintenance)

Claim 5. Katz teaches, (the method of claim 4), further comprising the step of:  
defining the one or more source systems to include loan information for one or more mortgages.

(lending data from all the offices of a financial institution).

Claim 6. Katz teaches, converting the received Loan information to a predetermined format for the financial system.

(col. 6 L 36+ “data is normalized to a standard format”)

Claims 7 and 8. Katz teaches, wherein said step of evaluating further comprises the step of:  
defining at least one of the one or more predetermined conditions as a financial event, and defining the financial event as a change in status for a loan.

(col. 7 L 32+ “certain types of information..such as credit line increases”).

Product claims 14-21 are analyzed in accordance with the respective method claims.

### ***Claim Rejections - 35 USC § 103***

13. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz.

Katz, fails to teach one or more specific financial events associated with the one or more staging tables. However, Official notice is taken that such events are old and well known in the art of loan processing and management. It would have been obvious to one of ordinary skill of

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the art at time of the invention to define the financial event as any type of financial events because it would allow the prior art of Katz to cover broad range of financial events and because it would improve Katz in terms of its usefulness.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

8/21/06